

## REMARKS

The Applicants respectfully request reconsideration of the application in view of the foregoing amendments and the following remarks. Support for new dependent claim 44 is located in various paragraphs of the specification, for example, at ¶ [0032] and ¶ [0033].

In the Office action mailed August 9, 2006 (“Office action”), the Examiner asserted a rejection of claims 1-6, 8-15 and 32-43 under 35 U.S.C. §101 as directed to non-statutory subject matter. The Examiner rejected claims 1-6, 8-15, and 32-43 under 35 U.S.C. §112, first paragraph, asserting that the claimed invention is not supported by a specific and substantial utility or a well established utility. The Office action asserted a rejection of claims 1-6, 8-15, and 32-43 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication 2002/0122067 to Geigel et al. (“Geigel”) in view of U.S. Reissued Patent No. RE38079 to Washino et al. (“Washino”) and further in view of U.S. Application Publication 2004/0250083 to Schwab (“Schwab”). The Applicants respectfully disagree.

### I. Interview Summary Supplement

The following discussion supplements the Interview Summary mailed by the United States Patent and Trademark Office on November 8, 2006. During the interview, the Applicants’ representative, Daniel H. Bell, and the United States Patent and Trademark Office’s Examiner, Mike Rahmjoo, discussed the rejection asserted against claim 1 in the Office action.

First, Applicants’ representative asked for further clarification of the Examiner’s asserted rejection under 35 U.S.C. § 101, which states “[a]s per claims 1-6, 8-15, 32-43 applicant recites a method including elements or steps which do not define any functional relationship of the processes described therein.” The Examiner stated that claim 1, for example, recited a set-top box and a television, but claim 1 did not require a set-top box or a television in order to perform the method step. Applicants’ representative stated that claim 1 is a method claim including steps, such as a step of “processing the image file copies to tailor the selected images according to memory size constraints of the removable storage medium and according to one or more display characteristics of the television,” but indeed performing claim 1 does not require the television or the set-top box. It requires only processing “image file copies” according to the “size constraints” and “display characteristics” of a set-top box and a television, respectively.

Applicants' representative further asserted that it is proper under the law and accepted practice for a process or method step to consider constraints and characteristics of external conditions, data, or information when performing a step in a method claim. Additionally, Applicants' representative pointed out that the utility was saving an album of photos to a removable media for transfer to a set-top box for display on a television. The Examiner indicated he would inquire into the basis for the §101 and §112(2) rejections further with his supervisor and withdraw the rejection or articulate more clearly the legal basis for the rejection if it is maintained.

Second, Applicants' representative discussed the Examiner's characterization of Washino at page 5, paragraph 1, of the Office action. Applicants' representative directed the Examiner to various passages in Washino that state that Figure 4 and Figure 7 describe a "video/audio production system" (col. 9, line 42) and a "universal television production system" (col. 13, line 29), as opposed to a set-top box. Further, there is no discussion of a set-top box in Washino, or using a removable storage medium to transfer an album to a set-top box for display on a television. Applicants' representative pointed out that the television production system of Figure 7 of Washino is described as receiving "signals from any of several sources, including conventional broadcast signals 210, satellite receivers 212, and interfaces to a high-bandwidth data network 214." (Col. 13, line 30-32.) These signals are "provided to the digital tuner" and "adapter" before being supplied to the "processor" (col. 13, lines 33-36). The "output of the processor 222 is provided to the internal data bus 226." (Col. 13, line 42-43.) The "hard disk drive controller 234 provides access to various storage means ... including a removable hard disk drive ... these storage units enable the PC to function as a video recorder" (col. 13, lines 47-52). Applicants' representative stated that to one of ordinary skill in the art, FIG. 7 of Washino is a sophisticated video production system implemented by a PC that receives broadcast and satellite signals, processes those signals, and saves those signals to a video recorder. Thus, Washino fails to teach or suggest, and in fact teaches away from, the recited "processing the image file copies ... according to memory size constraints of the removable storage medium and according to one or more display characteristics of the television ... and saving, to the removable storage medium, the album of images wherein the album of images is transferable via the removable storage medium to the set-top box for display on the television," such as recited in claim 1.

No agreement was reached and the interview concluded.

## II. Geigel, Washino, and Schwab

In the interest of reaching a shared understanding of the disclosures of Geigel, Washino and Schwab, the Applicants make the following observations.

Geigel describes a system and method for automatic layout of images in digital albums. (Geigel, Abstract.) A user inputs a collection of images, such as from a digital camera. (*See* Geigel, ¶¶ [0056], [0057], Figure 1.)

An Albuming Automation System (“AAS”) analyzes the images and lays out images within an album page or pages. (*Id.*) The AAS incorporates various principles of layout design in its decision-making processes. (Geigel, ¶¶ [0079] – [0084].)

As output, the AAS produces album pages. (Geigel, ¶¶ [0056], [0057], Figure 1.) According to Geigel, AAS output can be printed, displayed, or transferred to media such as a picture compact disc (“CD”). (*Id.*)

Washino describes an “audio/video production system” that “facilitates professional quality image manipulation and editing.” (Washino, Abstract.) Further, the “availability of hard-disk drives of progressively higher capacity and data transmission rates is allowing successively longer and higher resolution image” (Washino, col. 8, lines 31-33) to “facilitate editing and production activities, and it is anticipated that these units would be employed in much the same way as video cassettes are currently used in Betacam and other electronic news gathering (ENG) cameras and in video productions.” (Washino, col. 8, lines 41-46.)

Washino also describes a “video/audio production system” (Washino, col. 9, line 42) and a “universal television production system” (Washino, col. 13, line 29).

Schwab describes a system and method for secure interactive communication of text and image information between a central computer and one or more client computers located at remote sites. (Schwab, Abstract.) Remote client computers access the central database via a network connection. (Schwab, ¶ [0042].)

According to Schwab, item images and item text may be uploaded to the central computer via the remote computers. (Schwab, ¶ [0010].) Characteristics of items are used to search and sort the various items stored in a relational database. (Schwab, ¶ [0039]). Client computers search based upon item characteristics, and the searched images are displayed locally. (Schwab, ¶¶ [0082], [0076].)

**III. Claims 1, 6, 11, and 32.**

Claim 1 recites:

- h) processing the image file copies to tailor the selected images according to memory size constraints of the removable storage medium and according to one or more display characteristics of the television;  
...  
wherein the album of images is transferable via the removable storage medium to the set-top box for display on the television.

Claim 6 recites:

- j) save, to the removable digital storage medium, the one or more compressed image file copies that correspond to the selected images, wherein the album of images is saved on the removable storage medium in a format readable by the stand-alone set-top box for display on the television;

Claim 11 recites:

- e) means for prompting the user to save the selected images as the digital photo album of images, wherein the digital photo album is for viewing on the television coupled to the set-top box;  
...  
wherein the digital photo album is saved on the removable storage medium in a format for transferring to the set-top box for display on the television;

Claim 32 recites:

- j) save, to the removable storage medium, the one or more compressed image file copies that correspond to the selected images, wherein the album of images saved to the removable storage medium is readable by the set-top box for display on the television;

The proposed Geigel-Washino-Schwab combination fails to teach or suggest the above-cited language of claims 1, 6, 11 and 32, respectively.

The Office action states, for example:

“Geigel does not teach compressing the image file copies; and the album is for viewing on a television different from the first display device; and processing the image file copies to tailor the selected images according to memory size constraints of the removable storage medium and according to one or more display characteristics of the television; and saving, to the removable storage medium, the album of images comprising the compressed image file copies that correspond to the selected images, wherein the album of images is transferable via

the removable storage medium to the set top box for display on the television.”  
(Office action, page 4, ¶2.)

The Office action then cites the following language from Washino, however:

Production effects may be conducted in whatever image size is appropriate, and then re-sized for recording. Images are recorded by writing the digital data to storage devices employing removable hard-disk drives, disk drives with removable media, optical or magneto-optical based drives, or tape-based drives, preferably in compressed-data form. (Washino, col. 4, lines 45-50.)

This invention relates generally to video production, photographic image processing, and computer graphics design, and, more particularly, to a multi-format video production system capable of professional quality editing and manipulation of images intended for television and other applications, including HDTV programs. (Washino, col. 1, lines 15-19.)

In the preferred embodiment, the display is the monitor of a programmed personal computer, and computer interface modules connected between each camera interface module and the computer allow video images generated by the cameras to appear in different windows on the computer monitor. (Washino, col. 4, lines 1-5.)

[A]ccessing the program in the production format from the high-capacity storage [means] medium; (Washino, col. 17, lines 30-32.)

Applicants respectfully assert that Washino fails to teach or suggest “processing the image file copies to tailor the selected images according to memory size constraints of the removable storage medium and according to one or more display characteristics of the television ... wherein the album of images is transferable via the removable storage medium to the set-top box for display on the television,” as recited in claim 1. Washino also fails to teach or suggest the above-cited “set-top box” language of claims 6, 11 and 32, respectively.

For example, Washino states that “FIG. 3 shows the functional diagram for the storage-device-based digital recorder employed in the video camera, or separately in editing and production facilities.” (Washino, col. 8, lines 57-59.) Thus, the camera of Figure 3 includes a “removable hard disk drive 70.” (Washino, col. 8, line 60.) Additionally, the “video/audio production system” (Washino, col. 9, line 42) of FIG. 4 and the “universal television production system” (col. 13, line 29) of FIG. 7, describe removable hard-disk drives (Washino, col. 9,

line 47, col. 13, line 50). Thus, a camera and a production system is both described as having removable hard disk drives.

But there is no discussion in Washino of a set-top box and no discussion of an album of images that is transferable via the removable storage medium to the set-top box for display on the television after processing the image file copies to tailor the selected images according to memory size constraints of the removable storage medium and according to one or more display characteristics of the television.

The Office action states that “a program is translated into a variety of formats” at FIG. 4 in Washino, and then “transferable via the removable storage medium to the set top box (fig. 7 blocks 218, 220, 234 or 242 corresponding to the set top box) for display on the television.” (Office action, page 5, ¶ 1.) However, no such teaching is suggested anywhere in Washino. Instead, Washino describes both FIG. 4 and FIG. 7 as production systems. (Washino, col. 13, line 29, and col. 9, line 42.) FIG. 4 is titled as “a multi-format audio/video production system” (Washino, col. 9, line 42) and FIG. 7 is titled as a “universal television production system” (Washino, col. 13, line 30). Nothing in Washino would lead one of ordinary skill in the art (“OOSA”) to saving an album of images on a removable media for transfer to a “set-top box” as recited in claims 1, 6, 11 and 32, respectively. Rather, by comparing FIG. 4 and FIG. 7 and the accompanying discussions and elements in the drawings (e.g., figure elements 238=104, 240=102, 236=100, 234=106, 228=110, 242=132, 232=112, 230=114), OOSA would conclude that FIG. 7 is another version of the “production system” described in FIG. 4. Thus, FIG. 7 is another version of a video production system such as FIG. 4 that also includes inputs from “conventional broadcast signals 210, satellite receivers 212, and interfaces to a high bandwidth data network 214.” (Washino, col. 13, lines 31-32.)

*There is no transfer suggested between these two different  
embodiments of production systems in Washino.*

Thus, there is no saving for purpose of transfer of the removable storage medium from FIG. 4 to FIG. 7 and no set-top box described in Washino.

Schwab also fails to teach or suggest the above-cited language of claims 1, 6, 11 and 32, respectively.

Finally, there is no suggestion to combine Geigel and Washino as the Examiner has done, and one of ordinary skill in the art would be lead away from the combination. For example, Washino states:

For this application, a data storage unit 8 is provided to facilitate editing and production activities, and it is anticipated that these units would be employed in much the same way as video cassettes are currently used in Betacam and other electronic news gathering (ENG) cameras and in video productions.  
(Washino, col. 8, lines 40-46.)

A data storage unit used to *facilitate editing and productions activities* (as in Washino) teaches away from the recited arrangements of claims 1, 6, 11 and 32, respectively. Applicants have provided the Examiner with an Information Disclosure statement containing two references that support the position of teaching away. (DV vs. Betacam SP: 4:1:1 vs. 4:2:2, Artifacts and Other Controversies, <http://www.dvcentral.org/DV-Beta.html>, 12 pages, 1997, accessed November 18, 2006; Sony DVW-2000P “PAL” System Digital Betacam VTR, [http://www.bhphotovideo.com/product/389751-REG/Sony\\_DVW2000P\\_DVW\\_2000P\\_PAL\\_System\\_Digital.html](http://www.bhphotovideo.com/product/389751-REG/Sony_DVW2000P_DVW_2000P_PAL_System_Digital.html), 2 pages, accessed November 18, 2006.) Thus, Washino and Geigel fail to provide a suggestion to combine and instead lead away from the claimed arrangement. Even if a suggestion to combine had been shown, the two references once combined, fail to teach the recited arrangements.

The Examiner’s proposed combination fails to teach or suggest “processing the image file copies to tailor the selected images according to memory size constraints of the removable storage medium and according to one or more display characteristics of the television ... wherein the album of images is transferable via the removable storage medium to the set-top box for display on the television.” Thus, claim 1 should be allowable. The Examiner’s proposed combination also fails to teach or suggest the above-cited language of claims 6, 11 and 32, respectively.

In view of the foregoing discussion, the Applicants will not belabor the merits of the separate patentability of dependent claims 2-5, 8-10, 12-15, and 33-43. Claims 1-6, 8-15, and 32-43 should be allowable.

**IV. 35 U.S.C. §§ 101 and 112**

The Office action asserted a rejection of claims 1-6, 8-15, and 32-43 under 35 U.S.C. §§ 101 and 112(2). Claims 1-6, 8-15, and 32-43 are directed to allowable statutory subject matter for at least the reasons described above in the Interview Summary. Additionally, in *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02, the Supreme Court held that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces ‘a useful, concrete and tangible result’ – a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.” Thus, processing image file copies to tailor the selected images according to memory size constraints of the removable storage medium and according to one or more display characteristics of the television wherein the album of images is transferable via the removable storage medium to the set-top box for display on the television, is well within the confines set by the Supreme Court in *State Street*.

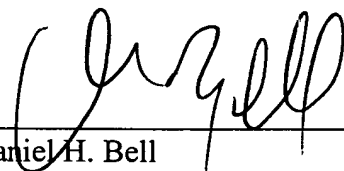
**CONCLUSION**

Claims 1-6, 8-15 and 32-43 should be allowable. Such action is respectfully requested. The Examiner is invited to call the undersigned attorney at the telephone number below if the Examiner believes that doing so would further the prosecution of the present application.

Respectfully submitted,

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